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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,648	02/27/2004	Peter K. Chu	8544-AFP/GDM	9157
20349	7590	02/21/2006	EXAMINER	
POLAROID CORPORATION PATENT DEPARTMENT 1265 MAIN STREET WALTHAM, MA 02451			HESS, BRUCE H	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/789,648	CHU ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Bruce H. Hess	1774

~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 7-15-04 (IDS) and 12-3-04 (IDS)
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 7-15-04 and 12-3-04
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

Claims 1-25 are rejected under 35 USC 112 (2) as being indefinite for the reasons set forth below:

- A. Claims 1-8, 11-18 and 21-25 recite an imaging member which can comprise only one "layer". By definition, a layer is a thickness of some material laid over or spread upon a surface. Consequently, an underlying support or substrate should also be recited;
- B. Claims 1-4, 12-14 and 22-25 recite a "first" color-forming layer without reciting a second "color-forming layer; and
- C. Claims 1-6, 8-16 and 18-25 recite a "first" chemical compound without reciting a second chemical compound.

Claims 1, 13, 21 and 22 are rejected under 35 USC 102 (b) as being anticipated by any of the patents to Naito et al. I (USP 5,663,115), Naito et al. II (USP 6,010,808), Tsutsui et al. (EP 0 576 015) or Suzuki et al. (EP 1 234 681).

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Naito et et al. I or II, Tsutsui et al. or Suzuki et al.

These patents all teach color imaging members comprising a substrate having a color-forming layer which employs a crystalline chemical compound which can be converted into a liquid in the amorphous form upon the application of heat. The aforementioned crystalline and amorphous forms have intrinsically different colors. Multiple color-forming layers can be present which can be yellow, magenta and cyan. The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine melting points and color-forming layer locations) fails to

render applicants' claims patentable in the absence of unexpected results. The pertinent portions of these patents are listed on International Search report submitted by applicants.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/788,963, claims 1-15 of copending Application No. 10/789,566 or claims 1-16 of copending Application No. 10/789,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the aforementioned applications teach specific examples of the chemical compounds generically taught by the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



B. HAMILTON HESS  
PRIMARY EXAMINER